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10/524,442	10/11/2005	John Anthony Foran	1817-0156PUS1	4459
2292 7590 08/31/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER ZAHR, ASHRAF A	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

**Application No.**

10/524,442

**Applicant(s)**

FORAN ET AL.

**Examiner**

Ashraf Zahr

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 32-51 are pending in this application. Claims 1-31 have been cancelled. Claims 32, 45-47 are independent claims.

### ***Specification***

2. The abstract of the disclosure is objected to because it is not in the proper format. Furthermore, no abstract was provided on the sheet that was present as the abstract. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: The applicant needs to place the appropriate headings in the appropriate position in the specification (i.e. "Detailed Description is where Brief Description should be).

Appropriate correction is required.

4. Claim 3 objected to because of the following informalities: Applicant should either place a comma between "computer" and "on" in the 7<sup>th</sup> line of the claim or delete one of "on the user computer" recited in the 7<sup>th</sup> line to clarify the claim language. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claim 40 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Regarding Claim 40**, a computer program is non-statutory as not being tangibly embodied in a manner so as to be executable. This is true even if the method of Claim 32 is a statutory method.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 32-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Li et al., US 2003/0115153 (Hereinafter, Li).**

**Regarding Claim 32**, Li discloses “a method of displaying on a user computer one or more logos, specific to the particular user, on the user computer contacting a website associated with a merchant computer in a communications system connecting the merchant computer and the user computer, the communications system being also connected to such additional systems server and user computers as may be necessary to carry out the method”. Applicant

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defines logo in his specification on page 1 line 30 to page 2 line 2 to “encompass not alone a device or word such as a trade mark which one would normally consider to be a logo but also data which is specific to a user or class of users e.g. Bonus saver scheme points provided by a specific scheme; payment instructions or other data”. Specifically, Li discloses a method of displaying information, including logos, images, and advertisements on a computer related to a user of the computer (Li, Fig 3b, ¶0026-0028).

Li also discloses, “preparing at least one logo for display on the user computer on the user computer contacting the merchant computer”. Specifically, Li discloses preparing a merchant icon with a logo and displaying it on a user’s computer (Li, ¶0028).

Li also discloses, “storing the logo and a logo identifier”. Specifically, the database server stores logs, user data, catalogs, etc (Li, ¶0028). Furthermore, the image server stores information related to the merchant and the appropriate image to display (Li, ¶0039).

Li also discloses, “additionally and separately storing the logo identifier on a user file”. Specifically, Li uses a cookie to identify the proper content that is associated with the user (Li, ¶0028).

Li also discloses, “on the user computer contacting a merchant computer and requesting the downloading of a merchant page having a call code. Specifically, paragraph 28 describes how a user contacts a merchant computer and downloads information to the user’s browser for display on the user’s computer (Li, ¶0028).

Li also discloses, "the user file is retrieved". Specifically, the cookie is retrieved and attached to the request (Li, ¶0051).

Li also discloses, "at least one logo identifier is extracted from the user file". Specifically, Li extracts the information from the cookie and uses it to determine if the user previously logged into the merchant site. It determines which merchant site the user logged into and which merchant sites the user prefers and requests a transaction from the user path (Li, ¶0052).

Li also discloses, "the logo identifier is used to extract the logo". Specifically, Li states that if the user is a Home Grocer user, the information utility recognizes the HomeGrocer cookie and places a merchant icon with the HomeGrocer Logo (Li, ¶0028).

Li also discloses, "the logo is added to the merchant page; and the logo and merchant page are sent to the user computer". Specifically, an image server replies to the message from the user browser by delivering the appropriate image (Li, ¶0053).

**Regarding Claim 33**, Li also discloses, "the method as claimed in claim 32, in which there is more than one logo identifier stored in the user file and on a request for downloading a merchant page the logo retrieved is chosen through user interactions". Specifically, Li discloses a user browser directing a site to communicate with another site (Li, ¶0026). Furthermore, Li discloses allowing the consumer to select from multiple logos from more than one merchant site (Li, ¶0028).

**Regarding Claim 34**, Li also discloses, “the method as claimed in claim 32, in which the logo extracted is chosen having regard to one or both of the identify and category of the merchant site having the merchant computer” Specifically, the sites in Li could be content sites such news sites or merchant site such as airline ticket providers (Li, ¶0025).

**Regarding Claim 35**, Li also discloses, “the method as claimed in claim 32, wherein the user file is stored in one of: a database (Li, ¶0030); and a cookie (Li, ¶0052)”. Specifically, Li discloses storing user information in both a database and a cookie in the respective paragraphs 30 and 52.

**Regarding Claim 36**, Li also discloses, “the method as claimed in claim 32, wherein the user file is stored on one or more of: the user computer; the merchant computer; and a systems server computer”. Specifically, Li discloses storing user information on a database (¶0030) a merchant site (Li, Fig 3a: node 20) or content site (Li, Fig 3a: node 10).

**Regarding Claim 37**, Li also discloses, “the method as claimed in claim 32, in which the preparatory steps further include obtaining information on the user and using the information to determine a specific logo identifier to store”. Specifically Li discloses maintaining a user Log U to determine the recipes that were accessed by the user (Li, ¶0030).

**Regarding Claim 38**, Li also discloses, “the method as claimed in claim 32, in which sequentially the steps are preformed of: the user computer contacts the merchant computer and requests the downloading of a page”. Specifically, Li discloses a user browser requests the recipe image from an image server (Li, ¶0049).

Li also discloses, “the merchant computer sends a page containing a request for the logo to the user computer”. Specifically, the information utility determine determines if the request has an attached cookie (Li, ¶0051).

Li also discloses, “the user computer requests the logo from the systems server computer by transferring the user file to the server computer”. Specifically, the information utility cookie is embedded in HTTP information following back and forth between the user’s browser and information utility (Li, ¶0051).

Li also discloses, “the server computer sends the logo to the user computer; and the user computer displays the page and logo”. Specifically, the image server replies to the message from the user browser by delivering the appropriate image (Li, ¶0053).

**Regarding Claim 39**, Li also discloses, “the method as claimed in claim 32, in which there is stored different sizes of the same logo and the size of logo is chosen for display having regard to one or both of: the identity of the merchant computer and the call code of the page”. Specifically, the image servers 640c-d



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are dedicated to generating images corresponding to the various user requests, and serving them. Each image server 640c-d may contain a content image handler for detecting that the user is registered with a merchant site 20 and for displaying the appropriate image, and a merchant image handler for deciding which image to display at the merchant site 20. Note that the images may be personalized for users, and hence may be generated dynamically (Li, ¶0039). Furthermore, when rendering the page for the content image handler of 640c or d detects that the user has issued a transaction and displays the appropriate image. (¶0042).

**Regarding Claim 40**, applicant claims the “computer program comprising program instructions for causing a computer to carry out some or all of the method of claim 32”. This claim is substantially similar to claim 32 and is therefore rejected based upon the same reasoning used to reject claim 32.

**Regarding Claim 41**, applicant claims “the computer program as claimed in claim 40, embodied on a record medium”. This claim is substantially similar to claim 32 and is therefore rejected based upon the same reasoning used to reject claim 32.

**Regarding Claim 42**, applicant claims “the computer program as claimed in claim 40, stored in a computer memory”. This claim is substantially similar to

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claim 32 and is therefore rejected based upon the same reasoning used to reject claim 32.

**Regarding Claim 43**, applicant claims “a computer programmed to carry out some or all of the method of claim 32”. This claim is substantially similar to claim 32 and is therefore rejected based upon the same reasoning used to reject claim 32.

**Regarding Claim 44**, Li also discloses “the method as claimed in claim 32 wherein each independent step is adapted to be sequentially carried out between two or more jurisdictions”. Specifically, the steps in Li are carried out between the users browser and one or multiple merchant sites (Li, ¶0025).

**Regarding Claim 45**, Li discloses “a method of displaying on a user computer one or more logos, specific to the particular user, on the user computer contacting a website associated with a merchant computer in a communications system connecting the merchant computer and the user computer, the communications system being also connected to such additional systems server and user computers as may be necessary to carry out the method” “. Applicant defines logo in his specification on page 1 line 30 to page 2 line 2 to “encompass not alone a device or word such as a trade mark which one would normally consider to be a logo but also data which is specific to a user or class of users e.g. Bonus saver scheme points provided by a specific scheme; payment

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instructions or other data". Specifically, Li discloses a method of displaying information, including logos, images, and advertisements on a computer related to a user of the computer (Li, Fig 3b, ¶0026-0028).

Li also discloses, "preparing at least one logo for display on the user computer on the user computer contacting the merchant computer". Specifically, Li discloses preparing a merchant icon with a logo and displaying it on a user's computer (Li, ¶0028).

Li also discloses, "storing the logo and a logo identifier. Specifically, the database server stores logs, user data, catalogs, etc (Li, ¶0028). Furthermore, the image server stores information related to the merchant and the appropriate image to display (Li, ¶0039).

Li also discloses, "additionally storing the logo identifier on a user file". Specifically, Li uses a cookie to identify the proper content that is associated with the user (Li, ¶0028).

Li also discloses, "the method comprising: receiving notification of a request having been received by a merchant computer for the downloading of a merchant page having a call code". Specifically, Li discloses that the transaction management server accepts user request, translates them, and issues the appropriate transaction request at the merchant site (Li, ¶0038).

Li also discloses, "retrieving the user file". Specifically, the cookie is retrieved and attached to the request (Li, ¶0051).

Li also discloses, "extracting at least one logo identifier from the user file". Specifically, Li extracts the information from the cookie and uses it to determine if

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the user previously logged into the merchant site. It determines which merchant site the user logged into and the merchant site that the user prefers and requests a transaction from the user path (Li, ¶0052).

Li also discloses, "retrieving the logo". Specifically, Li states that if the user is a Home Grocer user, the information utility recognizes the HomeGrocer cookie and places a merchant icon with the HomeGrocer Logo (Li, ¶0028).

Li also discloses, "having the logo sent for addition to the merchant page for display on the user computer". Specifically, an image server replies to the message from the user browser by delivering the appropriate image (Li, ¶0053).

**Regarding Claim 46,** Li discloses, "A method of displaying on a user computer one or more logos, specific to the particular user, on the user computer contacting a website associated with a merchant computer in a communications system connecting the merchant computer and the user computer, the communications system being also connected to such additional systems server and user computers as may be necessary to carry out the method, some or all of the merchant computer and the additional systems server and user computers are outside the jurisdiction and for which method there is available for the user computer having been previously prepared, at least one logo for display on the user computer and a logo identifier stored on a user file, the method comprising". Applicant defines logo in his specification on page 1 line 30 to page 2 line 2 to "encompass not alone a device or word such as a trade mark which one would normally consider to be a logo but also data which is specific to a user or class of

users e.g. Bonus saver scheme points provided by a specific scheme; payment instructions or other data". Specifically, Li discloses a method of displaying information, including logos, images, and advertisements on a computer related to a user of the computer (Li, Fig 3b, ¶0026-0028).

Li also discloses, "the user computer contacts the merchant computer". Specifically, paragraph 28 describes how a user contacts a merchant computer and downloads information to the user's browser for display on the user's computer (Li, ¶0028).

Li also discloses, "the user computer sends a request for the downloading of a merchant page having a call code". Specifically, Li discloses that the transaction management server accepts user request, translates them, and issues the appropriate transaction request at the merchant site (Li, ¶0038).

Li also discloses, "said request comprising additional instructions for the retrieval of the user file". Specifically, Li discloses utilizing the user profile information (Li, ¶0028).

Li also discloses, "extraction of at least one logo identifier from the user file". Specifically, Li discloses allowing the user to select from multiple logos if the user is a user of multiple merchant sites (Li, ¶0028).

Li also discloses, "retrieval of the logo" Specifically, an image server replies to the message from the user browser by delivering the appropriate image (Li, ¶0053).

Li also discloses, "the sending of the logo to the merchant computer with instructions to attach the logo to the merchant page". Specifically, an image

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server replies to the message from the user browser by delivering the appropriate image (Li, ¶0053).

Li also discloses, "and then, on the logo having been attached to the merchant page, the user computer receives the page and logo for subsequent use". Specifically, a merchant icon and a shopping icon are displayed (Li, ¶0027).

**Regarding Claim 47**, Li discloses, "a method of retrieving via a communications network one or more logos, specific to the particular user and subsequently displaying said retrieved logo on display means associated with a user computer operable by a user, wherein the displayed logo is associated with further electronic data such that when the displayed logo is selected by the user that user is able to communicate with a merchant site in a predetermined manner". Applicant defines logo in his specification on page 1 line 30 to page 2 line 2 to "encompass not alone a device or word such as a trade mark which one would normally consider to be a logo but also data which is specific to a user or class of users e.g. Bonus saver scheme points provided by a specific scheme; payment instructions or other data". Specifically, Li discloses a method of displaying information, including logos, images, and advertisements on a computer related to a user of the computer (Li, Fig 3b, ¶0026-0028).

Li also discloses, "(i) requesting a web page from a merchant computer adapted to run a website accessible via said communications network".

Specifically, paragraph 28 describes how a user contacts a merchant computer

and downloads information to the user's browser for display on the user's computer (Li, ¶0028).

Li also discloses, "(ii) transmitting the requested web page and a request for a logo to the user computer". Specifically, the image server replies to the message from the user browser by delivering the appropriate image (Li, ¶0053).

Li also discloses, "(iii) transmitting the request for the logo accompanied by a logo identifier from the user computer to a computing server". Specifically, a message is sent from a source site to a destination site, via the information utility (Li, ¶0026).

Li also discloses, "(iv) retrieving the logo identified by the identifier from a database associated with the computer server, and transmitting said retrieved logo to the user computer". Specifically, an image server replies to the message from the user browser by delivering the appropriate image (Li, ¶0053).

Li also discloses, "(v) displaying the logo and the web page on the user computer. Specifically, Li states that if the user is a Home Grocer user, the information utility recognizes the HomeGrocer cookie and places a merchant icon with the HomeGrocer Logo (Li, ¶0028).

**Regarding Claim 48**, Li discloses "the method as claimed in claim 47, which includes the pre-performed initial steps of"

Li also discloses, "(i) preparing and storing the logo for subsequent display on the user computer". Specifically, Li discloses the steps to prepare a recipe

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associated with code that are prepared to be displayed on a user's computer (Li, ¶0030).

Li also discloses, "(ii) associating an identifier with the logo so prepared". Specifically, a recipe has a code assigned to it (Li, ¶0030).

Li also discloses, "(iii) storing the identifier in a file associated with, and accessible by, the user computer". Specifically, that code is place marked in a database (Li, ¶0030).

**Regarding Claim 49**, Li also discloses, "the method as claimed in claim 47, wherein the further electronic data comprises instructions which facilitate a transaction between the user and the merchant". Specifically, Li discloses the user may be presented with a view of Peapod grocery items 501a-501g in a left view and one or more menus 410, including ingredients 401 in a right view. (Li, ¶0035).

**Regarding Claim 50**, Li also discloses, "the method as claimed in claim 47, wherein the electronic data comprises instructions which enable payment to a merchant". Specifically, Li discloses the user may be given the option to purchase each of the items on the shopping cart (Li, ¶0035).

**Regarding Claim 51**, Li also discloses, "the method as claimed in claim 47 wherein each independent step is adapted to be sequentially carried out



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between two or more jurisdictions". Specifically, the steps in Li are carried out between the users browser and one or multiple merchant sites (Li, ¶0025).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Hoyle**, US 6,771,290: Computer Interface Method and Apparatus With Portable Organization System and Targeted Advertising.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashraf Zahr whose telephone number is (571) 274-1973. The examiner can normally be reached on Mon.-Thurs., 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Coby can be reached on (571) 272-4017. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAZ  
9/20/2007

  
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